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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/930,960	08/17/2001	Vishnu K. Agarwal	M4065.0151 P151-A	2287

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[REDACTED] EXAMINER

DOAN, THERESA T

ART UNIT	PAPER NUMBER
2834	

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/930,960	AGARWAL ET AL.
	Examiner	Art Unit
	Theresa T Doan	2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) Responsive to communication(s) filed on 06 January 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-15 and 17-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-15 and 17-54 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:
1. received.
 2. received in Application No. (Series Code / Serial Number) _____.
 3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 18) Interview Summary (PTO-413) Paper No(s) _____
 19) Notice of Informal Patent Application (PTO-152)
 20) Other _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Okutoh et al. (6,201,271) as previously cited.

Okutoh et al. teach in figure 8 a capacitor, comprising:

an electrode having a layer 20 comprising platinum-rhodium and a layer 22 comprising platinum material on top of the platinum-rhodium layer wherein the layer comprising platinum-rhodium comprises approximately 3 to approximately 40 percent rhodium and approximately 60 to approximately 97 percent platinum (column 9, lines 1-5);

an upper electrode 24; and

a dielectric layer 23 of a ferroelectric or high dielectric constant dielectric material formed between the lower and upper electrodes, wherein the dielectric layer 23 is in contact with the platinum layer 22 of the lower electrode (column 8, lines 26-42).

3. Claims 1 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Okutoh et al. (6,180,974) as previously cited.

Okutoh et al. teach in figure 14 a capacitor, comprising:

an electrode having a layer 208 comprising platinum-rhodium and a layer 209 comprising PtRhO material on top of the platinum-rhodium layer wherein the layer comprising platinum-rhodium comprises approximately 3 to approximately 40 percent rhodium and approximately 60 to approximately 97 percent platinum (column 26, lines 16-18);

an upper electrode 213; and

a dielectric layer 210 of a ferroelectric or high dielectric constant dielectric material formed between the lower and upper electrodes, wherein the dielectric layer 210 is in contact with the platinum layer 209 of the lower electrode (column 28, lines 26-54).

4. Claims 1 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Desu et al. (5,790,366) of record.

Desu et al. teach in figure 1C a capacitor, comprising:

an electrode having a layer 100 comprising platinum-rhodium and a layer 110 comprising platinum material on top of the platinum-rhodium layer wherein the layer comprising platinum-rhodium comprises approximately 3 to approximately 40 percent rhodium and approximately 60 to approximately 97 percent platinum (column 5, lines 20-23);

an upper electrode (130,140,150); and
a dielectric layer 120 of a ferroelectric or high dielectric constant dielectric material formed between the lower and upper electrodes, wherein the dielectric layer 120 is in contact with the platinum layer 110 of the lower electrode (column 4, lines 7-64).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-54 are rejected under the judicially created doctrine of double patenting over claims 1-54 of U. S. Patent No. 6,297,527 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both U.S. Patent and instant application claimed multiplayer electrode for ferroelectric capacitors. Moreover, the claims 1, 14 and 38 in the U.S. No. 6,297,527 are either narrower version of the claims of the instant application or obvious variations thereof. For example, claim 38 in U.S. No. 6,297,527 "... the layer consisting of platinum material of the lower electrode" whereas claim 38 in the instant application claims "...the layer comprising platinum material of the lower electrode". Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to substitute a platinum material of lower electrode of U.S. Patent No. 6,297,527 with other metals or other compound that comprising platinum material as a design alternative.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

Applicant's arguments filed on 01/06/03 have been fully considered but they are not persuasive.

Applicant argues "Applicants respectfully disagree with the Office Action's contention that the claims of this case are obvious over the claims in Agarwal". The argument is not persuasive because claims 1-54 of U.S. Patent No. 6,297,527 and the claims 1, 4-15 and 17-54 of the instant application are not patentably distinct from each other because both sets of claims describe substantially identical structure as shown in figure 1.

The rest of applicant's arguments, addressed to the amended claims are considered in the rejections shown above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa T Doan whose telephone number is (703) 305-2366. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WAEL FAHMY can be reached on (703) 308-4918. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

TD
January 31, 2003

MVm ✓ M✓

Theresa Van Ngo
Examiner